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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/957,018	09/20/2001	Joseph E. Kaminkow	0112300-581	2458

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K&L Gates LLP
P.O. Box 1135
CHICAGO, IL 60690

EXAMINER	
MCCULLOCH JR, WILLIAM H	
ART UNIT	PAPER NUMBER
3714	

NOTIFICATION DATE	DELIVERY MODE
05/29/2009	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

chicago.patents@klgates.com

Office Action Summary	Application No.	Applicant(s)	
	09/957,018	KAMINKOW, JOSEPH E.	
	Examiner	Art Unit	
	William H. McCulloch	3714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *22 December 2008*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-4,6-12 and 14-25* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-4,6-12 and 14-25* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

1. This action is in response to amendments received 12/22/2008. Claims 1-4, 6-12, and 14-25 are pending in the application, with claims 1, 6, 8, 9, 14-16, 18, 21, 23, and 25 currently amended.

Response to Amendment

2. By the present amendment, each independent claim now states that an award is selected "regardless of an amount of any of the values" of the award(s). Claims 2, 10, 17, 20, 22, and 24 are directed toward selection of "at least the largest value of the predetermined sets." For purposes of this examination, the independent claims will be interpreted such that the award is generated by selecting an amount, which may be the largest amount (by virtue of the above-listed dependent claims), but without regard to the specific monetary or credit amount. By way of example, should two hypothetical sets of values include {1, 2, 3} and {4, 5, 6}, it is within the scope of the claimed invention to always choose the largest value regardless of what the value actually is (i.e., 3 or 6, respectively).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. Claims 1-4, 6, 8-12, and 14-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO 98/09259 to Bennett (hereinafter Bennett) in view of U.S.

6,174,235 to Walker et al. (hereinafter Walker) and U.S. 6,345,824 to Selitzky (hereinafter Selitzky).

Regarding claims 1, 6, 8-9, 14-16, 18-19, 23, and 25, Bennett teaches the following limitations:

- A gaming device (figs. 1,6), the gaming device comprising:
- A display device (display 11);
- An input device (touch sensitive areas on the display surface, see at least the abstract)
- A processor in communication with the display device and the input device (e.g., game control processor circuits, see at least the abstract; microprocessor, see at least p.3, ll. 11-15), wherein the processor is programmed, for each play of a game, to:
- Cause a plurality of masked selections to be displayed to a player by the display device (see at least figs. 2-4; p.3, ll. 25-28; and p.4, ll. 9-12);
- Associate a plurality of different values with the masked selections prior to said masked selections being picked by the player and without displaying which values are associated with which selections (see at least figs. 2-4 and p.3, ll. 11-31);
- Enable the player to pick a plurality of said masked selections for a designated number of predetermined sets (the Examiner interprets the entire game matrix of e.g., 3x3 selections to be the “predetermined set”);

- For each of the designated number of predetermined sets, determine a plurality of said values in said set by enabling the player to pick a plurality of said selections (interpreted as "masked selections") for said set wherein the plurality of values in each set are based on the values associated with the selections picked by the player for said set (see at least figs. 2-4 and p.3, ll. 11-31);
- Cause a display of each of the predetermined sets and the values in each set (see at least figs. 2-4);
- Generate a plurality of awards for each one of the predetermined sets by selecting a plurality of but not all of the values in each one of said sets (In Bennett, selections bearing a prize are selected (e.g. 5 credits), whereas "zero prize" zones are not used to generate the award(s); see at least p.2, ll. 17-19.);
- Generate a resulting award by performing at least one mathematical operation on the awards generated from each of the predetermined sets (adding the prize bearing selections and/or multiplying them by a bet of credits; see at least figs. 2-4 and p.3, line 32-p.4, line 19);
- Provide said resulting award to the player (see at least p.4, ll. 13-19).

Bennett teaches the invention substantially as described above, but lacks in explicitly teaching that the designated number of predetermined sets is at least two. In Bennett, there is one predetermined set of selections (e.g., the 3x3 game matrix in Figs. 2-4) for each game played. In a related disclosure, Walker teaches a selection game

best described in Figures 5-6 and 10, wherein the player chooses a plurality of masked selections from one or more sets of selections. The player's selections are then unmasked to reveal the prize value, if any, that was previously hidden from the player. With regard to Figure 10, Walker teaches that three game sets 300, 302, and 304 may be presented to the player, wherein the player selects at least one selection from each of the three game sets (see at least 9:17-25). It would have been obvious to one of ordinary skill in the art to modify Bennett to include at least two predetermined sets of selections as suggested by Walker because the substitution of one known element for another would have yielded predictable results. Additionally, one of ordinary skill in the art would have been capable of applying the known method of enhancing a base device (e.g., Walker's enhancing of a single set game to a multiple set game) in the prior art (e.g., Bennett's single set game) and the results would have been predictable to one of ordinary skill in the art. See *KSR International Co. v. Teleflex Inc.*

The combination of Bennett and Walker teaches the invention substantially as described above. The combination of references lacks in explicitly teaching selecting "at least one but not all of" the awards from the plurality of different sets in order to generate a resulting award, wherein the awards are selected regardless of any amount of any of the values. Selitzky teaches a game with a bonus feature wherein if the player's hand includes more than one bonus combination, only the highest ranking bonus combination is awarded (see at least 7:1-13). It would have been obvious to one of ordinary skill in the art at the time of invention to apply the teaching of Selitzky (only awarding the highest ranking bonus combination) to the invention of Bennett and

Walker in order to allow more award bearing selections (in Bennett) to be displayed on the screen without the provision of large awards paid by the gaming establishment, resulting in more frequent but smaller value awards being paid out by the gaming machine. Such a result is favorable to a gaming establishment because it allows customers to be frequently awarded (which results in more repeat customers) without the need for the gaming establishment to pay large sums.

Regarding claim 21, the combination of Bennett and Walker teaches the invention as described above, but lacks in explicitly stating that each of the associated values is greater than zero. Such a limitation lacks criticality in the invention, as evidenced by the fact that all prior and numerous existing claims make no mention of the particular values to be assigned to each selection. It would have been an obvious matter of design choice, well within the capabilities of one of ordinary skill in the art to assign a value greater than zero to each of the selections. Moreover, the functionality of Bennett would not be rendered unsatisfactory by such modification. The claimed invention requires that each associated value be greater than zero, but also requires that at least one but less than all of the values in a given set be used to generate an award. This is tantamount to assigning a value greater than zero, but preventing the player from receiving the value (in other words providing a zero value) for at least one of the selections. In other words, the non-awarded values of Bennett (such as the "O's" generated by the gaming device) could be assigned values greater than zero, but because the player is not awarded these values, the fundamental invention of Bennett would be unchanged.

Claims 3-4, and 11-12 are explained above with regard to the independent claims. Regarding claims 2, 10, 22, and 24, Bennett teaches selecting at least the largest value or award of each set (see at least p.3, line 32-p.4, line 19).

Bennett describes claims 17, 20, and 24, as shown with regard to claims 2, 10, 22, and 24 above. Bennett describes claim 19 with respect to claims 1, 6, 9, 14, 21, and 25 above.

5. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bennett, Walker and Selitzky in view of Admitted Prior Art.

Regarding claim 7, the combined teaching of Bennett, Walker, and Selitzky lacks in explicitly teaching that the display device displays the selections and reveals values associated with the selections that are not picked by the player. The Examiner, in a previous rejection, took Official Notice that it was notoriously well known in the art at the time of invention to display the non-chosen values, in addition to the chosen values. One of ordinary skill in the art at the time of invention would have been motivated to do so in order to indicate to the player what he or she could have selected. Applicant failed to adequately challenge the Examiner's Official Notice and it is now considered Admitted Prior Art.

Response to Arguments

6. Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to William H. McCulloch whose telephone number is (571) 272-2818. The examiner can normally be reached on M-F 9:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter Vo can be reached on (571) 272-4690. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/W. H. M./
Examiner, Art Unit 3714
5/26/2009

/Peter D. Vo/
Supervisory Patent Examiner, Art Unit 3714